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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,303	10/09/2001	Nobuo Ogasawara	47410/JEC/F179	8147

23363 7590 04/26/2004

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,303

Applicant(s)

OGASAWARA, NOBUO

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed (as Paper No. 17) in this application after final rejection (Paper No. 16). Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office Action (Paper No. 16) has been withdrawn pursuant to 37 C.F.R. §1.114.

### ***Acknowledgements***

2. In conjunction with the RCE noted above, Applicant's amendment filed January 23, 2004 (Paper No. 18) is acknowledged. Accordingly, claims 1, 2-9 remain pending.
3. The amendment to the specification filed with the claim amendments has been entered.
4. The proposed drawing corrections are approved by the Examiner.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

### ***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

6. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 2-9, 34, are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the corresponding structure of the “means for reading” and the “means for electronically recording” remains indefinite. For example, the checkout terminal (POS) terminal is duplicative since Applicant recites this corresponding structure in both the “means for reading” and the “means for electronically recording.” It is believed that there are *not* two POS terminals for claim 1.

Alternatively, the Examiner recognizes that the corresponding structure may also include electrical representations of software programmed within a computing device.<sup>1</sup> However Applicant’s table from his remarks<sup>2</sup> does not show that such electrical representations in a magnetic or other media are *his* corresponding structure. Therefore another way to overcome this rejection (and if the original specification so permits) would be to include software programmed within *e.g.* the POS device. By including software programmed within the POS device—therefore clearly linking and associating the corresponding structure (*i.e.* POS device, software and other necessary structural elements) to the claimed function—the ‘means for’ phrases would be structurally different thus negating the §112 2<sup>nd</sup> paragraph rejection.

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<sup>1</sup> “[A] computer-implemented means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification.” *Creo Products Inc. v. Presstek Inc.*, 305 F.3d 1337, 1345, 64 USPQ2d 1385, 1389 (Fed. Cir. 2002) citing *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1348, 51 USPQ2d 1385, 1391 (Fed. Cir. 1999). The Examiner notes that the computer must actually be *programmed* and not “capable of” or “adapted to” being programmed.

<sup>2</sup> Applicant’s Remarks in Paper No. 18, Page 10.

***Claim Rejections - 35 USC §103***

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2-9, and 34-40, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz et. al. (U.S. 5,923,735) ("Swartz") in view of Sone (U.S. 6,204,763). Swartz discloses a means for determining shelf-life information for items (displaying it on a computer monitor); means for recording shelf-life information and a data store (an ordinary computer hard drive or barcode); mean accessible to a POS terminal (74) for reading recorded information and a scanner (a first barcode scanner at the hospital pharmacy) attached to a first terminal; means for electronically recording the shelf-life information (a barcode) and an IC card (customer card); a touchscreen unit; means for storing electronic shelf-life information (a computer keyboard); means for formatting (the video driver in the computer); means for displaying as an on-screen display (a computer monitor); shelf-life limitation information includes a period for which the product remains viable (inherent in all shelf-lives); and an electronic receipt (the record of customer purchases downloaded from the store sever); a processor coupled to the means for retrieving (with the CPU), the processor adding shelf-life information to the inventory list of products.

Swartz does not directly disclose the processor detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory files. Sone teaches processor detecting an expired product based upon the shelf-life limitation

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information and removing the expired product from the inventory list. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Swartz as taught by Sone to include detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory list. Such a modification would have resulted in better inventory management by alerting the customer to purchase additional product (e.g. milk) if the product's expiration date was reached at home.

10. Claims 1, 2-9, and 34-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz in view of Rivalto (U.S. 5,482,139). Swartz discloses and does not disclosed as noted above. Rivalto teaches removing dates and/or perishable goods from the inventory by knowing precisely when the particular expiration dates will occur.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Swartz as taught by Rivalto to include detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory list. Such a modification would have helped the user implement e.g. the process in Rosenweig et. al. (U.S. 6,188,991 B1) ("Rosenweig") where the user could determine which recipes could be made from the user's inventory. By removing this an expired product from inventory, it would be as if the product didn't exist allowing the user to prepare more healthier foods.

11. Except for the 35 U.S.C. 112 6<sup>th</sup> paragraph issues noted this and previous office actions, the Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First

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and as noted in the previous Office Action,<sup>3</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.<sup>4</sup> Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>5</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>6</sup> to be his own lexicographer.<sup>7</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process

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<sup>3</sup> See the Examiner's previous Office Action on the merits mailed October 30, 2003, Paper No. 16, Paragraph No. 16.

<sup>4</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>5</sup> See again the Examiner's previous Office Action, Paper No. 16, Paragraph No. 16.

<sup>6</sup> *Id.*

<sup>7</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed April 19, 2004).

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and except where 35 U.S.C. 112 6<sup>th</sup> paragraph is invoked, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation . . . ." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>8</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>9</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

### ***Response to Arguments***

12. Applicant's arguments filed January 23, 2004 (part of Paper No. 18) have been fully considered but they are not persuasive.

13. After review of the specification and except for the issues noted above regarding §112 2<sup>nd</sup> paragraph, the Examiner adopts Applicant's positions regarding the corresponding structure for the associated §112 6<sup>th</sup> paragraph phrases as noted by Applicant in his table in the Remarks on pages 9-11 in Paper No. 18.

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<sup>8</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>9</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]"

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14. The Examiner also acknowledges Applicant's remarks noting that there may be other structures or equivalents other than the corresponding structure noted in Applicant's table making such corresponding structure noted in Applicant's table exemplary.

15. Applicant's remaining arguments with respect to the claims have also been considered but are moot in view of the new grounds of rejection.

### *Conclusion*

16. The following references are considered pertinent to Applicant's disclosure: Tedesco et. al. (U.S. 5,988,346).

17. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position

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regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks/Arguments" (Paper No. 18 beginning on page 8) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>10</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Patent Examiner  
Art Unit 3627

AJF  
April 19, 2004

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<sup>10</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.